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SUBJECT Appeal Brief (09/998,392)

Number of Pages 17

Date 5/23/2006

MESSAGE

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1. one copy of a Fax Transmittal Form;
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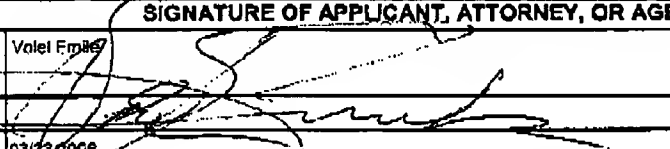
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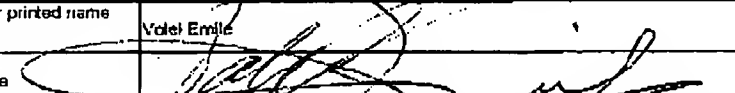
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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	00998,392
	Filing Date	11/29/2001
	First Named Inventor	Bhupesh Gupta
	Art Unit	2176
	Examiner Name	Gauram Satn
Total Number of Pages in This Submission	Attorney Docket Number	AUS920011027US1

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.62 or 1.63	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance communication to Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below): Supplemental Amendment
Remarks Notice of Appeal		
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm or individual name	Volei Emile	
Signature		
Date	03/23/2006	

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Appl. No. 09/998,392
Appeal Brief Transmittal dated 05/23/2006
Reply to Office Action of 01/11/2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of:	:
Bhupesh Gupta	:
Serial No: 09/998,392	: Before the Examiner:
	: Gautam Sain
Filed: 11/29/2001	: Group Art Unit: 2176
Title: APPARATUS AND METHOD	: Confirmation No.: 7315
OF HIGHLIGHTING CATEGORIZED	:
WEB PAGES ON A WEB SERVER	:

TRANSMITTAL OF APPELLANTS' BRIEF UNDER 37 C.F.R. 1.192(a)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attached is Appellant's Brief from a decision of the Examiner dated 01/11/2006, finally rejecting Claims 1 – 15.

The item(s) marked below are appropriate:

1. _____ A petition and fee for extension of term for reply to the final rejection is attached.
2. X Appeal fee
 X other than a small entity. Fee: \$500.00
3. X Payment
 X Please charge Deposit Account **09-0447** the sum of \$500.00. A duplicate of this notice is attached.

AUS920011027US1

Page 1 of 2

Appl. No. 09/998,392
Appeal Brief Transmittal dated 05/23/2006
Reply to Office Action of 01/11/2006

The Commissioner is hereby authorized to charge any additional fee,
which may be required or credit any overpayment to Deposit Account No. 09-
0447.

Respectfully Submitted

By: 

Volel Emile
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Registration No. 39,969
(512) 306-7969

AUS920011027US1

Page 2 of 2

MAY 23 2006

Appl. No. 09/998,392
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OF HIGHLIGHTING CATEGORIZED	:
WEB PAGES ON A WEB SERVER	:

APPELLANTS' BRIEF UNDER 37 C.F.R. 1.192

Assistant Commissioner of Patents
Washington, D. C. 20231

Sir:

This is an appeal to a final rejection dated January 11, 2006 of claims 1 - 15 of Application Serial Number 09/998,392 filed on November 29, 2001. This brief is submitted pursuant to a Notice of Appeal filed on March 31, 2006 in accordance with 37 C.F.R. 1.192.

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AUS920011027US1

Page 1 of 11

Appl. No. 09/998,392
Appeal Brief dated 05/23/2006
Reply to Office Action of 01/11/2006

BRIEF FOR APPLICANTS – APPELLANTS

(i)

Real Party in Interest

The real party in interest is International Business Machines Corporation (IBM), the assignee.

(ii)

Related Appeals and Interferences

There are no other appeals or Interferences known to appellants, appellants' representative or assignee, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(iii)

Status of Claims

All claims in the Application (i.e., Claims 1 – 15) have been finally rejected.

(iv)

Status of Amendment

No amendment was filed after the Final Rejection of January 11, 2006.

(v)

Summary of Claimed Subject Matter

In one embodiment, the invention provides a method of highlighting categorized Web pages on a Web server. According to the teachings of the invention, when there is a list of Web pages on a server arranged by categories, a comparison will be made between the Web pages in the list and Web pages in a bookmark folder on a user's computer system. All the Web pages in the list that are the same as the Web pages in the bookmark folder will be highlighted. This then tells the user that the (highlighted) Web pages on the server have

AUS920011027US1

Appl. No. 09/998,392
Appeal Brief dated 05/23/2006
Reply to Office Action of 01/11/2006

already been bookmarked (see page 21, lines 28 – 32, page 22, lines 1 – 16 as well as Fig. 17).

In another embodiment, the invention provides a method of indicating Web pages on a server that have already been bookmarked on a local computer system. Accordingly, when a user accesses a Web site on a server on which Web pages are arranged in categories, the Uniform Resource locators (URLs) of all bookmarked Web pages in a bookmark folder on the computer system being used by the user are retrieved. Then the URLs of the bookmarked Web pages are compared with URLs of the Web pages in the categories. All Web pages in the categories displayed on the Web site that have the same URLs with the bookmarked Web pages are highlighted. This notifies the user of the Web pages on the server that have already been bookmarked (see again page 21, lines 28 – 32, page 22, lines 1 – 16 as well as Fig. 17).

(vi)

Grounds of Rejection to be Reviewed on Appeal

Whether the claims were properly rejected under 35 USC 103(a) as being unpatentable over Nation in view of Burke.

(vii)

Arguments

In considering a Section §103 rejection, the subject matter of the claim "as a whole" must be considered and analyzed. In the analysis, it is necessary that the scope and contents of the prior art and differences between the art and the claimed invention (taken as a whole) be determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

Nation teaches a method of indicating when clickable image links of hypertext image maps of a computer web browser has been traversed.

AUS920011027US1

Appl. No. 09/998,392
Appeal Brief dated 05/23/2006
Reply to Office Action of 01/11/2006

According to Nation, various web browsing software packages or other hypertext software packages keep a history of various nodes or links that a user has previously visited. This is done to indicate whether a node or link has already been visited anytime thereafter. The indication usually entails changing some feature of the text, e.g., color, font, underline, etc. But, until the disclosure of Nation, the indication only applied to textual links of alphanumeric characters. Nation then provides a method to also indicate whether a clickable image has already been visited.

Specifically, when a clickable graphical image is to be displayed, it is determined, using a history of image links that have been previously visited, whether the clickable image has been traversed. If so, some sort of a marker is used to indicate that the clickable image has already been traversed.

However, Nation does not teach, show or suggest the steps of ***comparing bookmarked Web pages in a bookmark folder with Web pages arranged in categories on a server, and highlighting all the Web pages in the categories that are the same as the bookmarked Web pages*** as claimed.

The Examiner admitted that Nation does not teach the step of comparing reproduced above but asserted that Burke does provide such step. Applicants disagree.

Burke purports to provide a system for storing bookmark files in a remote location. According to Burke, a bookmark file that is stored on a local computer system (i.e., a system that is being used by a user) may also be stored remotely for anytime availability including when the local computer system is inoperative. When a bookmark file is being stored at the remote location by the user and if the user had already stored a bookmark file at the remote location, the bookmarks in the file being stored and the bookmarks in the previously stored file may be merged together. The bookmarks in the bookmark file being stored may be stored in categories in which bookmarked pages from the previously stored bookmark file are stored. The categories may be in accordance with a master set of theme and topic codes. In this case, individual bookmarked pages from
AUS920011027US1

Appl. No. 09/998,392
Appeal Brief dated 05/23/2006
Reply to Office Action of 01/11/2006

the file being stored will have been given a topic and theme code by the local system. After storing the bookmark file at the remote location, the user may at anytime download the bookmark file to any local system.

Thus, Burke teaches that the bookmarks just received are arranged in accordance with their encoded theme and topic. However, just as in the case of Nation, Burke does not teach, show or so much as suggest the step of ***comparing Web pages that have been bookmarked in a bookmark folder with the Web pages in the categories***

Since neither Nation nor Burke, alone or in combination, teaches the above-emboldened-italicized limitations of the claims, Applicants submit that the claims are allowable over the applied references. Hence, applicants respectfully request withdrawal of the rejection and passage to issue of the claims.

Respectfully Submitted

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AUS920011027US1

Page 5 of 11

Appl. No. 09/998,392
Appeal Brief dated 05/23/2006
Reply to Office Action of 01/11/2006

(vii)

Claims Appendix

1. (Previously presented) A computer implemented method of highlighting Web pages arranged in categories on a server comprising the steps of:

comparing bookmarked Web pages in a bookmark folder with the Web pages in the categories; and

highlighting all the Web pages in the categories that are the same as the bookmarked Web pages.
2. (Previously presented) The computer implemented method of Claim 1 wherein the bookmark folder is on a client.
3. (Previously presented) The computer implemented method of Claim 1 wherein the bookmark folder is on a server.
4. (Original) A computer program product on a computer readable medium for highlighting Web pages arranged in categories on a server comprising:

code means for comparing bookmarked Web pages in a bookmark folder with the Web pages in the categories; and

code means for highlighting all the Web pages in the categories that are the same as the bookmarked Web pages.
5. (Previously presented) The computer program product of Claim 4 wherein the bookmark folder is on a client.

AUS920011027US1

Appl. No. 09/998,392
Appeal Brief dated 05/23/2006
Reply to Office Action of 01/11/2006

6. (Previously presented) The computer program product of Claim 4 wherein the bookmark folder is on a server.

7. (Previously presented) A computer implemented apparatus for highlighting Web pages arranged in categories on a server comprising:

means for comparing bookmarked Web pages in a bookmark folder with the Web pages in the categories; and

means for highlighting all the Web pages in the categories that are the same as the bookmarked Web pages.

8. (Previously presented) The computer implemented apparatus of Claim 7 wherein the bookmark folder is on a client.

9. (Previously presented) The computer implemented apparatus of Claim 7 wherein the bookmark folder is on a server.

10. (Original) A computer system for highlighting Web pages arranged in categories on a server comprising:

at least one memory device for storing code data; and

at least one processor for processing the code data to compare bookmarked Web pages in a bookmark folder with the Web pages in the categories and to highlight all the Web pages in the categories that are the same as the bookmarked Web pages.

AUS920011027US1

Appl. No. 09/998,392
Appeal Brief dated 05/23/2006
Reply to Office Action of 01/11/2006

11. (Previously presented) The computer system of Claim 10 wherein the bookmark folder is on a client.

12. (Previously presented) The computer system of Claim 10 wherein the bookmark folder is on a server.

13. (Previously presented) A computer implemented method of highlighting Web pages arranged in categories on a server comprising the steps of:

accessing a Web page on the server on which Web pages arranged in categories are displayed;

retrieving Uniform Resource locators (URLs) of all Web pages in a bookmark folder, the bookmark folder being stored either on a client computer system or on the server, the bookmark folder, if stored on the server, being enabled to be accessed by a plurality of users;

comparing the URLs of the bookmarked Web pages with URLs of the Web pages in the categories; and

highlighting all the Web pages in the categories displayed on the Web page that have the same URLs with the bookmarked Web pages.

14. (New) A computer implemented method of indicating Web pages on a server that have already been bookmarked on a remote computer system comprising the steps of:

accessing a Web site on the server on which Web pages arranged in categories are displayed;

AUS920011027US1

Appl. No. 09/998,392

Appeal Brief dated 05/23/2006

Reply to Office Action of 01/11/2006

retrieving Uniform Resource locators (URLs) of all bookmarked Web pages in a bookmark folder, the bookmark folder being stored on the remote computer system and being enabled to be viewed by a plurality of users, however, only bookmarked Web pages in the bookmark folder for which a user has access permission may be accessed by the user;

comparing the URLs of the bookmarked Web pages with URLs of the Web pages in the categories; and

highlighting all the Web pages in the categories displayed on the Web page that have the same URLs with the bookmarked Web pages.

15. (New) A computer implemented method of indicating Web pages on a server that have already been bookmarked on a local computer system comprising the steps of:

accessing a Web site on the server on which Web pages arranged in categories are displayed;

retrieving Uniform Resource locators (URLs) of all bookmarked Web pages in a bookmark folder, the bookmark folder being stored on the local computer system;

comparing the URLs of the bookmarked Web pages with URLs of the Web pages in the categories; and

highlighting all the Web pages in the categories displayed on the Web site that have the same URLs with the bookmarked Web pages.

AUS920011027US1

Appl. No. 09/998,392
Appeal Brief dated 05/23/2006
Reply to Office Action of 01/11/2006

(lx)

Evidence Appendix

No evidence was submitted pursuant to 37 C.F.R. §§ 1.130, 1.131 and 1.132 nor was there any evidence entered by the Examiner relied upon by Appellants in this appeal.

AUS920011027US1

Page 10 of 11

Appl. No. 09/998,392
Appeal Brief dated 05/23/2006
Reply to Office Action of 01/11/2006

(x)

Related Proceedings Appendix

There are no decisions rendered by a court or the Board that would have a bearing on the Board's decision in the pending appeal.

AUS920011027US1

Page 11 of 11